

REMARKS

Reconsideration of the Final Office Action of November 14, 2002 respectfully is requested. This Amendment is in response to that Office Action. There previously was a Notice of Appeal and Extension of Time filed on March 14, 2003, which set a date for filing the appeal brief as May 14, 2003. Concurrently filed with this Amendment is an Extension of Time and accompanying fee to extend the time of response until September 15, 2003 since September 14, 2003 is a Sunday.

Currently claims 1-22 are pending in this patent application with claims 5, 11, 12, and 17-20 withdrawn from consideration. Claims 4, 10, 13, and 14 have been allowed. Claims 1-3, 6-9, 15, 16, 21, and 22 are currently rejected.

Claim 15 has been amended to recite that the regulating components are present in a space formed by the upper platform and the lower housing. Claim 16 has been amended to improve readability and more clearly define the invention. As has been discussed in prior amendments, the art does not disclose, teach, and/or suggest a "stopper" as that element is defined in the specification. Therefore, the Applicant respectfully submits that the amendment to claim 16 is not an amendment to obtain in response to an outstanding rejection, and therefore is not subject to the *Festo* doctrine.

35 U.S.C. §112 rejection

The Final Office Action has rejected claim 2 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant considers as the invention. This rejection is respectfully traversed.

Applicant continues to be confused regarding the rejection of claim 2, because this rejection was previously made in the first Office Action and withdrawn in the second Office Action.

"The horizontal plane" is inherent and does not require an antecedent recitation, because the gripping area is angled based on the recitation of "a tall upright portion" and "a short upright portion" in claim 1. See MPEP 2173.05(e). Thus, "the horizontal plane" is inherent as existing due to the gripping area being angled and one way to describe such an angle is relative to "the horizontal plane" as was done in claim 2. See,

e.g., specification p. 8, lines 6-8, p. 27, lines 15-16. Additionally, when an individual reads the claim they would understand that "horizontal plane" is being used as a reference plane to define the structure recited in claim 2. Applicant respectfully requests that this indefiniteness rejection be withdrawn.

35 U.S.C. §102(b) - Thomas, Jr.

Claim 15 has been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Thomas, Jr. (U.S. Pat. No. 4,768,778). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found . . . in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of Calif.*, 2 USPQ.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 9 USPQ.2d 1913, 1920 (Fed. Cir. 1989)(citations omitted). In this regard, Applicant respectfully submits that the invention as claimed includes elements not expressly or inherently described in Thomas.

Claim 15 recites that the regulating components are within a space formed by the upper platform and the lower housing. Thomas discloses a belt 98 that is placed on the outside of the Thomas device as illustrated in Figure 7. However, there is nothing within the base 22 and the rotating platform 24 for regulating the ability for having these two components rotate relative to each other. Applicant respectfully requests that this rejection be withdrawn.

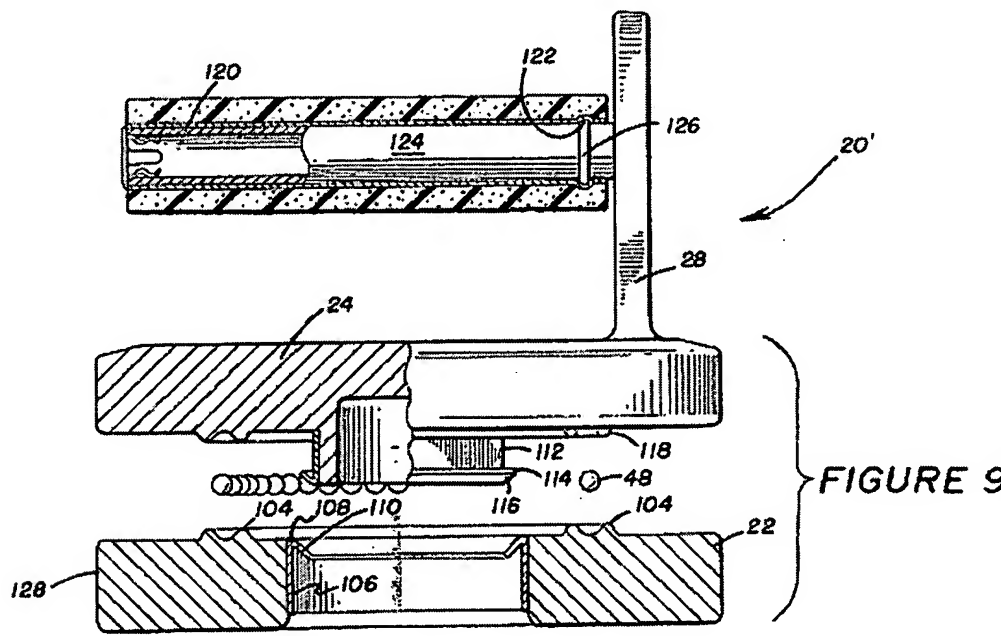
35 U.S.C. §103 - Thomas, Jr.

Claim 16 has been rejected under 35 U.S.C. §103(a) as allegedly anticipated by Thomas, Jr. This rejection is respectfully traversed.

The applicant has the right to be his own lexicographer and define terms in the specification in particular ways for use in the claims. See, e.g., *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 990 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). When the applicant defines a term, that definition is to be used in analyzing the claims. See *Johnson Worldwide Assocs., Inc.*, at 990; *In re Paulsen*, at 1480.

Claim 16 recites a stopper that is capable of engaging the lower housing and the upper housing such that the two housings will not rotate relative to each other. The stopper is described and defined, for example, in the last paragraph on page 9 of the specification and illustrated, for example, as element 156' in Figures 3(a)-(c). The specification defines the stopper as any component that is capable of engaging an opening passing through the lower housing and an opening passing through a wall extending down from the upper platform. *Id.*; claim 16.

The first bearing surface 110 and second annular lip 114 with a second bearing surface 116 of Thomas are incapable of providing resistance and stopping power to preventing the rotating platform 24 from rotating relative to the base 22. See col. 7, lines 10-31, Fig. 9. In fact, the very names of these elements indicate these elements are present in Thomas for allowing the rotating platform 24 to rotate relative to the base 22, which is contrary to the recited stopper in claim 16. In addition, the opening that is referred to in paragraph 7 of the Office Action is not an opening that if plugged would prevent rotation of the rotating platform 24 relative to the base 22, since the item that would be inserted into that opening, which is parallel to the rotating platform 24, would be on the central axis of rotation of the rotating platform 24. See Thomas, Fig. 9 (reproduced below).



Thomas also fails to teach the openings recited in claim 16 that are present in the wall extending down from the upper platform and the lower housing.

Additionally, the proposed modification of Thomas to include a "stopper" would destroy the purpose of the disclosed device. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)(finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose). Thomas makes it clear that a purpose of the invention is to allow for the rotating platform 24 to rotate relative to the base 22 in view of the problem that during a push-up it is natural for the wrist to want to go through a twisting motion. See Thomas, col. 1, lines 18-60. When Thomas does add resistance to his device, rotation still occurs between the rotating platform 24 and the base 22 only the level of resistance increases. Thomas, col. 6, lines 28-45.

Applicant respectfully submits that reconsideration and withdrawal of the present rejection is proper and such action is respectfully requested.

35 U.S.C. §103(a) - Thomas combination

Claims 1-3, 21 and 22 have been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Thomas in view of Montgomery (U.S. Pat. No. 5,226,868) and Karstadt (U.S. Pat. No. D141,456). This rejection is respectfully traversed.

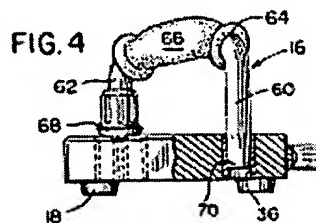
"There is no suggestion to combine . . . if a reference teaches away from its combination with another source 'A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . . [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.'" *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360, 52 USPQ2d 1294 (Fed. Cir. 1999)(citing *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). If a first reference (Thomas) does teach away from a second reference (Montgomery), then that fact alone can defeat an obviousness rejection based on a combination using these two references. See *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1350, 53 USPQ2d 1580 (Fed. Cir. 2000).

Thomas teaches that an existing problem with the push-up exercise, which as part of the exercise it is natural for the wrists to twist simultaneously with the movement of the arms during both the extension and retraction. Thomas, col. 1, lines 29-31. However, the "traditional push-up exercise does not allow this twisting motion and consequently the strain of resisting the natural motion must also be absorbed by the wrist." Thomas, col. 1, lines 31-34. Thomas goes on to state that "a fist push-up does nothing to eliminate the stress created by resistance to the natural twisting motion." Thomas, col. 1, lines 45-47. At the end of the background section, Thomas confirms the problem being addressed by stating none of the known prior devices "assist in alleviating the strain on the delicate wrist bones and muscles occurring during the exercising event of a push-up." Thomas, col. 2, lines 44-46. Thomas also states an advantage of the device as "allowing the user to follow the natural **rotational** movement of his body during the push-up exercise." Thomas, col. 3, lines 32-35 (emphasis added). Even when an external resistance is applied to the device (or a pair of devices), the rotating platform 24 is still able to rotate relative to the base 22. See Thomas, col. 4, lines 13-26 and Fig. 2; col. 6, lines 28-45 and Fig. 7.

On the other hand, Montgomery lists as one of the objects of his device is to provide

a power push-up device having a push-up board onto which are pivotally mounted two C-shaped handles having one end fitable into the board and the opposite end having an anti-skid cushion **to lock the position of the handles during push-up exercises.**

Col. 2, lines 32-37 (emphasis added). See Montgomery, Fig. 4 (reproduced below).



The objective to lock the handles in place is repeated using the same language in the next three stated objectives. See col. 2, lines 42, 50, 60. One of ordinary skill in the art when reviewing Montgomery would be taught that the device has handles that are

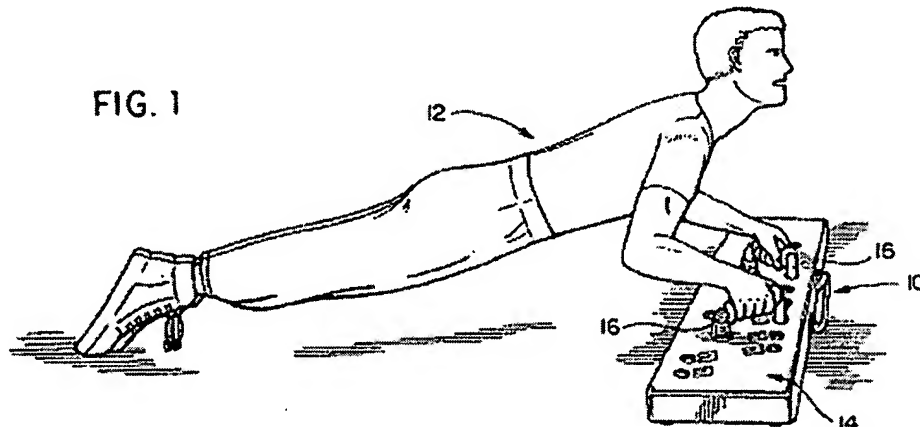
stationary once placed on the board and remain stationary during the push-up exercise, and would not consider taking the disclosed handle and combining it with a handle from Thomas, because Thomas requires that its handle is rotatable. Therefore, under *Winner Int'l Royalty Corp.* this is not a proper combination.

Applicant respectfully submits that the reliance upon Karstadt is improper because Karstadt is nonanalogous art, because the Office Action has failed to provide a rationale as to why the relevant standard is met. The standard for determining whether a piece of art is nonanalogous is 1) whether the art is within the field of the inventor's endeavor, and 2) if the art is not, then to determine whether the art is reasonably pertinent to the particular problem which the invention solves. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313 (Fed. Cir. 1986). Karstadt is a design patent for an iron, which is clearly outside the field of exercise devices and more particularly, push-up devices. The second prong is also not satisfied because an iron design is not reasonably pertinent to the problem solved by the invention as described in, for example, the background of the invention of this patent application. Additionally, common sense would not reasonably lead a person of ordinary skill into searching through the iron art to find a solution to a problem arising in connection to exercise devices. See *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ.2d 1443 (Fed. Cir. 1992). Therefore, claims 1-3 and 21 are patentable because Karstadt is nonanalogous art and is not within the knowledge of one of ordinary skill in the art. Furthermore, Karstadt offers no motivation, teaching or suggestion for making this combination.

Therefore, claim 1 is patentable over the alleged combination of Thomas, Montgomery, and Karstadt. Claims 2, 3, and 21 are also patentable because of their dependency from claim 1. In an attempt to further prosecution if the Examiner disagrees with the above, Applicant will offer these additional reasons for patentability in connection to claim 21.

Claim 21 recites a method for using the device recited in claim 1 including a specific placement of the pinkie on each hand on a respective device, i.e., adjacent the tall upright portion. Based on the patents relied upon by the Examiner, it is quite clear that Montgomery teaches the placement of the pinkie by the short upright as illustrated

in Figure 1 (reproduced below), which provides the description for how the user would use the conglomeration proposed by the Examiner. See *also* Montgomery, Fig. 4 (reproduced above)(shows a side view of the handle in the board).



Additionally, someone who is ironing typically places their pinkie adjacent to the rear of the iron, which would be adjacent to the upright having a wider gripping area in Figure 2 of Karstadt. After selective use of the patents (which is contrary to established precedent, see *In re Fine*, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988)), a combination is proposed in the Office Action that places the wider gripping area adjacent to the short upright, which provides a second statement out of the three patents for placement of the user's pinkie. Thomas is silent as to location, because its handle is completely horizontal and parallel to the floor with one free end, which allows the handle to rotate about its axis. The placement of the user's pinkie in claim 21 is not to increase the difficulty but to address ergonomical concerns that are not addressed or discussed in any of the art relied. See specification, p. 8, lines 9-15. See *also* specification, p. 2, lines 27-28, p. 3, line 7. An exerciser upon seeing the claimed invention would instinctively grab the handle in the manner described by Montgomery, and thus it is counterintuitive to grab the handle as recited in the method of claim 21.

Now turning to the rejection of claim 22, the Office Action fails to discuss claim 22 in terms of the asserted combination. This probably is because none of the patents discusses placing any type of element inside of the respective devices for regulating the rotation between the upper platform and the lower housing. In fact, Montgomery and Karstadt by their very nature would have no use for that capability since there is no

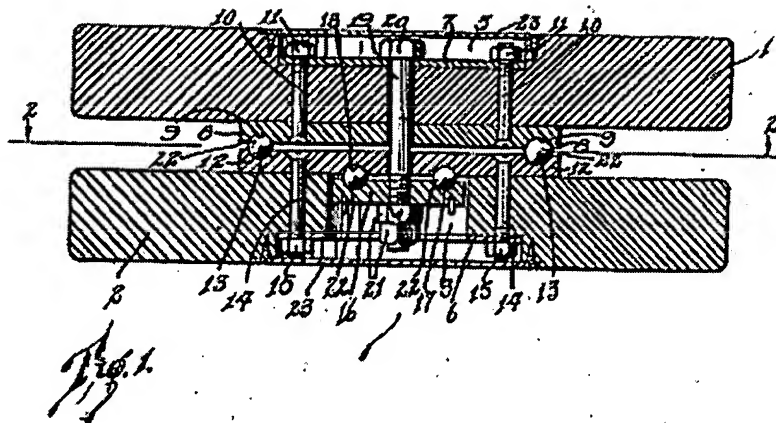
rotation between the handle and the rest of the device. Thomas only discloses the placement of a belt 98 around the outside of the device, and thus the belt 98 is external to the base 22. Additionally, as discussed above Applicant submits that claim 16, from which claim 22 depends, is patentable over Thomas.

Therefore, Applicant respectfully submits that reconsideration and withdrawal of the present rejection is proper and such action is respectfully requested.

35 U.S.C. §102(b)/103(a) - Hovda

Claims 6, 7 and 9 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated by or, in the alternative, under 35 U.S.C. §103(a) as allegedly obvious over Hovda (U.S. Pat. No. 1,533,500). This rejection is respectfully traversed.

The nuts 21, screw bolt (only partially threaded) 19, and head (which is the head of screw bolt 19) 20 of Hovda should not be considered to be regulating components as recited in claim 6. See Hovda, p. 1, lines 77-83. These three elements in Hovda form the central pivotal members. The device disclosed in Hovda is for teaching the concepts of the conservation of angular momentum and/or energy of rotation. Hovda, p. 1, lines 9-13 and p. 1, line 101 to p. 2, line 27. The entire purpose of the device is to have the two discs 1 and 2 be able to freely rotate relative to each other without having the amount of rotation restricted. Therefore, elements 19, 20, and 21 are disclosed for the purposes of holding the two discs together. In fact as illustrated in Figure 1 (reproduced below) of Hovda, bolt head 20 and nuts 21 are like two pieces of bread in a sandwich where the filler is disc 1, bearing plate 8 with circular groove 9, antifriction balls 22, bearing plate 12 with circular groove 13 and circular groove 18, antifriction balls 22 in the circular groove 18, and a lower portion. The lower portion includes lower disc (or plate) 2 that is shaped like a donut connected directly to bearing plate 12 and in the center of the donut is plate 16 with circular groove 17 that matches circular groove 18. The screw bolt 19 passes through respective holes in disc 1 and bearing plates 8 and 12. The screw bolt 19 is threaded to plate 16 and "[n]uts 21 are provided for locking the plate 16 in its adjusted position." Hovda, p. 1, lines 77-83. The screw bolt 19 and nuts 21 are not meant to be adjusted and in fact can not be adjusted as the screw bolt 19 only is partially threaded as shown in Figure 1 (reproduced below).



This interpretation is confirmed by claim 1, which recites "a central pivotal member for securing said discs together." Hovda, p. 2, lines 36-37. See also Hovda claim 2. Therefore, Hovda does not disclose regulating components including an adjustment mechanism as recited in claim 6. Applicant respectfully submits that claim 6 is not anticipated by Hovda.

Additionally, Hovda does not teach or suggest the invention recited in claim 6, because one of ordinary skill in the art reading the Hovda patent would determine that it teaches away from a device having "regulating components that control rotation between said lower housing and said upper platform" as recited in claim 6. Hovda, p. 1, lines 9-21. See *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448, 230 USPQ 416 (Fed. Cir. 1986)(a reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered (*citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984))); *In re Gordon*. Therefore, Hovda is unable to teach or suggest claim 6. Claims 7 and 9 are likewise patentable over Hovda in view of their dependency from claim 6.

Additionally, the rejection of claim 7, which recites that the regulating components include friction material, based upon threads being present on screw bolt 19 of Hovda is insufficient. Hovda does not disclose any friction material or other resistance causing component, particularly in view of the discussion above regarding the entire purpose of the Hovda device is for education regarding angular momentum, which requires a free spinning device. This purpose also prevents the modification of

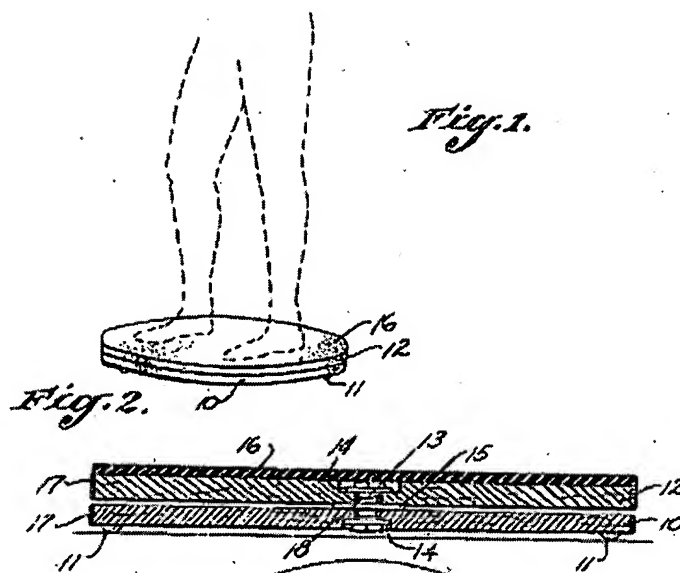
Hovda to include friction material, because the device would become inoperable for its purpose. See *Bausch & Lomb, Inc.*, at 448; *In re Gordon*. It is submitted that screw bolt 19 of Hovda is not identical to the friction material recited in claim 7, nor can it teach or suggest the recited friction material in claim 7.

Therefore, Applicant respectfully submits that reconsideration and withdrawal of the present rejection is proper and such action is respectfully requested.

35 U.S.C. §103(a) - Hovda/Titus

Claim 8 has been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Hovda in view of Titus (U.S. Pat. No. 2,256,001). This rejection is respectfully traversed.

Claim 8 is submitted as being patentable over this combination in view of its dependency from claim 6, which is submitted above as being patentable. Additionally, Hovda teaches away from this combination since a stated objective is "to provide a device consisting of a revolvable disc mounted thereon for supporting the demonstrator, and so constructed that the base and the revolving disc may be used interchangeably, that is to say, the base may be used as a supporting disc, or vice versa." Hovda, p. 1, lines 26-36. The Office Action fails to explain how adding a footing to lower plate 2 will still allow the Hovda device to be flipped over and have lower plate 2 available to be stood upon for a demonstration, because Hovda discloses an educational tool not an exercise device. The device disclosed in Titus is only operable for its purposes when the rubber feet (or footings) 11 are against the floor and not when plate 10 is on top. See Titus, Figs. 1 and 2 (reproduced below). Therefore, Applicant respectfully submits that the combination of Hovda and Titus is improper, because the modification of Hovda with footings defeats one of the objectives of Hovda.



Therefore, Applicant respectfully submits that reconsideration and withdrawal of the present rejection is proper and such action is respectfully requested.

Applicant acknowledges the Examiner's allowance of claims 4, 10, 13, and 14.

In view of the above amendments and Remarks, it courteously is urged that all the claims are allowable and that the application now is in condition for allowance. If the Examiner believes that the prosecution could be advanced through a telephone conversation, then the Examiner is invited to telephone the undersigned. Favorable action in this regard earnestly is solicited.

Respectfully submitted,
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